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IN THE

Supreme Court of the United States

Nos. 9, 10, 11. October Term, 1940.

No. 9.

The Schriber-Schroth Company, *Petitioner*,

v.

The Cleveland Trust Company, Chrysler Corporation, *Respondents*.

No. 10.

The Aberdeen Motor Supply Company, *Petitioner*,

v.

The Cleveland Trust Company, Chrysler Corporation, *Respondents*.

No. 11.

The F. E. Rowe Sales Company, *Petitioner*,

v.

The Cleveland Trust Company, Chrysler Corporation, *Respondents*.

MEMORANDUM FOR PETITIONERS IN RE RESPONDENTS' MOTION FOR LEAVE TO FILE AND SECOND PETITION FOR REHEARING UPON THE MERITS AND UPON THE MOTIONS TO REMAND.

John H. Bruninga,
John H. Sutherland,
Attorneys for Petitioners.

St. Louis, Missouri,
February 27, 1941.

Press of Byron S. Adams, Washington, D. C.

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The "Preliminary Considerations" (pages 4 to 7 of the Second Petition for Rehearing) demonstrate that our adversaries are either unable or unwilling to understand what to us seems plain in this Court's decision. Being wrong in their "Preliminary Considerations", Respondents are

wrong in their argument and in their conclusions. The preliminary considerations are wrong as follows:

1. That Point (1) of the Petition for Writ of Certiorari did not involve a question of whether the proceedings in the Patent Office operated to make the Jardine patent invalid is perfectly apparent from a reading of Reason I (page 8), Specification of Errors 1 (pages 12, 13) and Point I of the Argument (pages 14 *et seq.*) of the Petition for Writ of Certiorari and Brief accompanying same, as well as the corresponding portions of our Brief on the merits. The point was not that the Patent Office proceedings rendered the Jardine patent invalid, but that the Patent Office proceedings precluded Respondents or the courts from reading flexible webs into Jardine's claims in order to make them valid when they were otherwise invalid.

2. In its opinion, the Court did not disapprove Petitioners' contention, but plainly stated the contention thus (page 7) "the question now presented is whether, in view of the amendments and their withdrawal, the patent can rightly be construed as including the flexible webs in the claims allowed"; and decided it thus (page 9): "the latter (the allowed claims) cannot be construed as including that (flexible web) feature".

3. This Court declared no rule of estoppel in its decision. In the footnote, page 5, Second Petition for Rehearing, it is pointed out that *Permutit* v. *Graver*, 284 U. S. 52, did not "mention file wrapper estoppel". *Neither did the Court's decision in this case mention estoppel.*

4. The Court did not decide that Jardine's claims should rightly be interpreted as implying flexibility of the webs, as stated by Respondents, but on the contrary the Court assumed (page 5 "that if in the present case the specification and claims of the patent were

to be interpreted without reference to its file wrapper history" the flexible web feature might be construed in. But the Court points out at page 7 that claims "must be read and interpreted with reference" to the file history. Even if we assume as the basis of all thinking upon the subject matter that at the time of soliciting and issuing of the patent, Jardine was entitled to a claim for the combination of the allowed claims plus flexible webs, it does not follow that, having failed to make such a claim, the patentee is now entitled to claim such a thing by construction.

5 and 6 are both dependent upon 3.

7. By its amendment of February 3rd, the Court simply made clearer what it had stated in its original opinion; namely that the surrender of a claim particularizing the flexible web feature precluded the construction of that feature into an allowed claim, especially when the Court below had found that the allowed claim was of zero patentability without it.

In Answer to the Argument on Estoppel.

Since the Court's decision does not depend on any technical estoppel, Respondents' arguments re estoppel* are empty.

The Court succinctly said, in both its original and its amended decision, that because of what happened in the Patent Office, flexible webs cannot be construed from Jardine's specification into his claims.

Thus the Court applied the familiar rule of interpretation or construction of ambiguous written instruments in

*We question the "principle" as stated by Respondents, (p. 7), because it seems to imply that no one is estopped by doing or saying a thing unless he realizes at the time that he is going to be estopped thereby. It is not essential that one should realize the legal consequences of his act in order that the act should constitute an estoppel, when acted upon by another. Such would be inconsistent with the maxim that ignorance of the law excuses no one.

the light of the negotiations—the giving and taking—which led to their execution.

To borrow from Respondents' bovine example regarding Bessie and Daisy* (pages 8 and 9) no court would compel B to take Daisy when "contemporaneous acts or papers indicate that A intended to sell, and B intended to buy, Bessie".

Our presentation, as well as the Court's disposition of this case was based upon the proposition that the negotiations between Jardine and the Patent Office, as reflected by the file wrapper history, showed that it was not the intention of the Patent Office, or the intention of Jardine, that his allowed claims should be patentably characterized by flexible webs (see Petition for Writ of Certiorari, pages 4 to 6 and 14 to 17; Petitioners' Brief, pages 29 to 35; and decision of the Court, page 7). See also pages 2-5 of Petitioners' Reply dated January 15, 1941, where we carefully point out the meaning of the familiar name (or possibly misname) "file wrapper estoppel".

Whether the file wrapper evidences a technical estoppel is beside the point, although we believe that it establishes all of the elements of an estoppel, to-wit:

(a) Jardine at one time claimed to be the inventor of a piston having "the common flexing or yielding bending." **

(b) The Patent Office ruled against Jardine, and he acquiesced in the ruling by cancelling his claims. He then proceeded to claim something else, but never con-

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*We do not agree with Respondents' conclusion that A would not be estopped to deny that Bessie was the subject of the conveyance when the contemporaneous acts or papers indicated that "A intended to sell, and B intended to buy, Bessie."

**Respondents no longer argue that Jardine did not surrender claims to "the common flexing or yielding bending", (Second Petition for Rehearing, page 16), but now argue about "deformation bending."

tended* that the flexible web contributed to the patentability of the "something else".

(c) The Patent Office and the public, including these Petitioners, relied upon Jardine's acquiescence as a disclaimer** of any pretense that the flexible web contributed to the patentability, or constituted, a feature, of his alleged invention.

This was indeed a representation that Jardine relied upon things other than web flexibility as entitling him to a patent. The Patent Office and the public have acted upon that representation. As shown in Petitioners' Reply dated January 15, 1941, pages 14-15, Respondents contended, before the Master, in the District Court, in the Court of Appeals and before this Court, that flexible webs were *not* the distinguishing feature of the Jardine patent. So we submit that, although this Court did not rely upon it, Jardine is, in reality, estopped now to contend otherwise.

In Re "Deformation" Bending.

This is a new way of saying what was said in Respondents' green brief, which we answered, pages 1 and 2 of our Rejoinder Brief dated January 23, 1941.

Material Difference.

"Material difference" is not merely a difference in words—it is a difference in patentable substance. See "MATERIALLY (PATENTABLY)" page 5, Petitioners' Reply dated January 15, 1941. The synonymousness was not disputed by Respondent.

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*"The only normal inference from such silence is either that it was deemed immaterial whether the (webs were rigid or flexing), or that if a (flexing web) is preferable, it was not claimed because it lacked novelty." *Permutit* v. *Graver*, 284 U. S. 52, l. c. 59.

**"Cancellation—amounts to a disclaimer" this Court's decision page 8.

The patentable substance of the allowed claims (without flexible webs) was found by the Court below to be nothing (O).

The patentable substance of the claims particularizing flexible webs, which Jardine surrendered, was something (X).

So the "material difference" is

X—O=X

As to the Conclusion.

Respondents' puffing about the wonders of Jardine's invention has no basis in the evidence. It is fully answered (p. 8) of Petitioner's Reply Brief dated October 19, 1940.

While Respondents have reviewed at length the equities in their favor, we deem it unnecessary to further burden the Court with a recapitulation of the equities in favor of Petitioners. This litigation has been not only vigorously contested, but prolonged probably beyond the expectation of either of the litigants. We hope it is now at an end.

It is respectfully submitted that the Motion For Leave to File The Second Petition For Rehearing should be denied.

Respectfully submitted,

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St. Louis, Missouri,
February 27, 1941.

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